

Remarks

In response to the Appeal Brief filed April 18, 2005, the Examiner rejected remaining claims 4 and 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 7, 8 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kato et al. (United States Patent No. 6,082,761) in view of Dickinson et al. (United States Patent No. 6,726,418). Additionally, claims 1-5 and 7-11 are rejected under Section 103(a) as being unpatentable over Tajima et al. (United States Patent No. 6,485,048) in view of Dickinson et al.

Amendments to the Drawings

In the attached Replacement Sheet, Figure 3 has been amended to more clearly show that “the cushion retention tab [24] extends through the air bag cover [17], for at least partially supporting the air bag [16] and the air bag cover [17]” as recited in claim 4. As is made clear at page 1, paragraph [0012] of the Application:

Extending out through openings in the air bag cover are the cushion retention tabs. The cushion retention tabs are integrally attached to the air bag, and are used to help attach the air bag to the roof rail.

Claim 4 is further supported at page 2, paragraph [0025] which provides that:

The air bag 16 has a plurality of cushion retention tabs 24 and 24', see FIG. 4. The two cushion retention tabs 24, shown in FIG. 1, are captured between the mounting tabs 22 and snap-in clips 26 to further secure the air bag module to the bracket 18.

Furthermore, page 2, paragraph [0026] states that:

Each of the cushion retention tabs 24, 24', see also FIG. 4, are attached to the air bag 16, which is contained within an air bag cover 17.

Accordingly, amended Figure 3 is fully supported by the Specification and does not present new matter. With the change to Figure 3 made in the Replacement Sheet, the rejections of claims 4 and 5 under Section 112, second paragraph are believed to be overcome.

Rejections under Section 103(a): Kato et al. in view of Dickinson et al.

The Examiner rejects claims 1, 7, 8 and 10 under Section 103(a) as being unpatentable over Kato et al. in view of Dickinson et al. Applicants submit that Dickinson et al. does not qualify as prior art under 35 U.S.C. Section 102 and, therefore, may not be used as the basis for a rejection under Section 103(a). Furthermore, even assuming that Dickinson et al. were prior art, one skilled in the art would have no motivation to use the teachings of Dickinson et al. to modify Kato et al. as set forth by the Examiner. Both of these arguments are set forth in detail below.

Dickinson et al. is not Prior Art

The Examiner does not specify which subsection of Section 102 she relies upon to establish that Dickinson et al. is prior art. Dickinson et al. was filed August 6, 2002, claims priority to a provisional application filed September 19, 2001, resulted in a United States Patent Application Publication No. 2003/0053884 on March 20, 2003 ("Dickinson Application Publication") and issued as United States Patent No. 6,726,418 on April 27, 2004. Applicants submit that Dickinson et al. is not prior art under any subsection of Section 102. First, the attached Declaration under 37 C.F.R. § 1.131, which is hereby incorporated by reference in its entirety, and the Record of Invention incorporated therein as Exhibit B, establishes that Applicants first conceived of the invention as claimed in claims 1, 7-8 and 10 no later than October 27, 1998 (see Item 3 of the attached Declaration). Other evidence presented in the

Declaration and described in items 2 and 4-6 thereof establishes conception before and certainly not later than April 27, 2001, the date by which all of the inventors had signed the Record of Invention. Items 5-8 of the Declaration establish diligence from just before Dickinson et al.'s provisional application filing date of September 19, 2001 to constructive reduction to practice by filing on March 1, 2002. Therefore, Dickinson et al. does not predate Applicants' date of conception and, because Applicants have proven diligence over the requisite time period from just prior to the filing of the Dickinson et al. provisional application to Applicants' March 1, 2002 filing date, Dickinson et al. does not qualify as prior art under Section 102(a) or Section 102(e). Neither do Dickinson et al. nor the Dickinson Application Publication qualify as prior art under Section 102(b): Dickinson et al. did not issue and the Dickinson Application Publication was not published more than one year before the March 1, 2002 filing date of the present application. Applicants assume that the Examiner is not relying on any of subsections (c), (d), (f) or (g) in combining Kato et al. and Dickinson et al. and, in any event, submit that none of these subsections is satisfied. Accordingly, because each reference relied upon in a rejection under Section 103 must qualify as prior art under Section 102, Applicants submit that the rejection under Section 103(a) based on Kato et al. in view of Dickinson et al. is improper.

Modifying Kato et al. in view of Dickinson et al. is Nonobvious

Even assuming, *arguendo*, that Dickinson et al. is prior art, the rejection under Section 103(a) over Kato et al. in view of Dickinson et al. is improper. The Examiner relies upon Kato et al.'s air bag module (M1) and snap-in clip 24 which she finds "able to be attached to the roof rail and to the cushion retention tab (best seen in figures 3-5)." Furthermore, the Examiner finds that "[i]nstallation of the air bag module to the vehicle is accomplished by inserting the snap-in clip to the roof rail (best seen in figures 3,4)."

The Examiner admits that "Kato et al. do not disclose the snap-in clip being permanently attachable to the roof rail and selectively attachable to the cushion retention tab, the snap-in clip including a fastening portion, or a removable serviceability attachment feature," as required by claim 1. Accordingly, the Examiner relies upon Dickinson et al. to find:

Snap-in clip (including #10) able to be permanently attached to the roof rail (via #36a, 36b) and selectively attached to the air bag mounting portion (via #18, 20), and including a fastening portion (including #18)[.]

(Office Action, page 4)

Furthermore, the Examiner finds that Dickinson et al.'s snap-in clip 10 includes:

Removable serviceability attachment feature (including #20) able to attach the air bag module at the mounting portion to the snap-in clip by fastening the serviceability attachment feature to the fastening portion of the snap-in clip (best seen in figure 5; columns 5-6), and able to selectively detach the air bag module from the snap-in clip for removal of the air bag module for service by removing the serviceability attachment feature from the fastening portion of the snap-in clip (column 6, lines 47-53).

A snap-in clip with a removable serviceability attachment feature such as taught in Dickinson et al. would never be used in place of Kato et al.'s clip 24, as clip 24 is clearly not accessible. As shown in Kato et al.'s Figure 3, the mounting portion 30a of closure 30 prevents access to the clip 24. In the view of Figure 4, taken at a different cross-sectional location, clip 24 is surrounded by mounting portion 32a. Nothing short of destroying mounting portions 30a, 32a will allow access to the clips 24. Accordingly, if Dickinson et al.'s snap-in clip 10 were used in place of Kato et al.'s clip 24, it would be impossible to fasten or remove Dickinson et al.'s bolt 20 (or if any snap-in clip with serviceability attachment feature were used for that matter, it would be impossible to fasten or remove the serviceability attachment feature). It is well accepted that if the proposed modifications or combinations of the prior art would change the principle of operation of the prior art invention being modified, then the teachings are not

sufficient to render the claims *prima facie* obvious. MPEP 2143.01; discussing *in re Ratti*, 270 F.2d 810, 813; 123 USPQ 349, 352 (CCPA 1959) where an obviousness rejection was reversed because the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” Thus, because Dickinson et al.’s snap-in clip 10 and serviceability attachment feature 20 is rendered unsatisfactory for its intended purpose (i.e., the serviceability attachment feature 20 is rendered useless because it is inaccessible) if used with Kato et al.’s air bag module, the rejection under Section 103(a) of claims 1, 7-8 and 10 over Kato et al. in view of Dickinson et al. is improper.

Rejections under Section 103(a): Tajima et al. in view of Dickinson et al.

The Examiner rejects claims 1-5 and 7-11 under Section 103(a) as being unpatentable over Tajima et al. in view of Dickinson et al. Applicants submit that Dickinson et al. does not qualify as prior art under Section 102 and, therefore, may not be used as the basis for a rejection under Section 103(a). Furthermore, even assuming that Dickinson et al. is prior art, one skilled in the art would have no motivation to combine the teachings of Tajima et al. and Dickinson et al.

Dickinson et al. is not Prior Art

Applicants have explained above why Dickinson et al. is not prior art. Accordingly, because each reference relied upon in a rejection under Section 103 must qualify as prior art under Section 102, Applicants submit that the rejection under Section 103(a) based on Tajima et al. in view of Dickinson et al. is improper.

Modifying Tajima et al. in view of Dickinson et al. is Nonobvious

Even assuming, *arguendo*, that Dickinson et al. is prior art, the rejection of claims 1-5 and 7-11 under Section 103(a) over Tajima et al. in view of Dickinson et al. is improper. First, with respect to the Examiner’s finding that Tajima et al. has an:

Air bag cover (including #27) protectingly covering the air bag and having a tear seam along one edge (any portion of the cover #27 can be a tear seam; column 9, lines 17-19)
(Office Action, page 6)

Applicants note that the Examiner-named cover 27 is actually just a strip of tape. As recited in Tajima et al.:

After the air bag 23 is folded, a tape material 27, which is capable of being torn and which is for preventing the air bag 23 from losing its folded shape, (referring to FIGS. 5 and 6) is wrapped at a predetermined interval.

(Tajima et al., column 8, lines 9-13)

Thus, strips of the tape material 27 are wrapped periodically along the length of the folded air bag 23. In light of this knowledge, referring to Figure 20, it is clear that the cushion retention tab 26 does not "extend through the air bag cover [the tape material 27]" as required by claim 4, but is adjacent to the tape material 27 along the length of the air bag. Thus, in Figure 20, the tab 26, is either forward or rearward of the tape material 27, but does not extend through the tape material 27. (As set forth in column 7, lines 14-18, the actual air bag cover 15 of Tajima et al. includes general portion 16 and door portion 21.) Accordingly, all of the elements and limitations of claim 4 are not found in Tajima et al. A *prima facie* case of obviousness requires that the prior art references teach or suggest all claim limitations of the examined claim. (MPEP 2143.03) Thus, because neither Tajima et al. nor Dickinson et al. provide a "cushion retention tab [that] extends through the air bag cover" as required by claim 4, neither claim 4 nor claim 5 which depends therefrom is properly rejected under Section 103(a) over Tajima et al. in view of Dickinson et al.

The rejection of claims 1-5 and 7-11 under Section 103(a) over Tajima et al. in view of Dickinson et al. is also improper because one of ordinary skill in the art would have no

motivation to combine the teachings of the two references. Tajima et al.'s air bag module M3 is secured to the roof head lining 5 with a bolt 35 that passes through too many components to motivate one of ordinary skill in the art to use a snap-in clip in combination therewith.

As best viewed in Figure 4, the bolt 35 referred to by the Examiner (shown in Figures 14 and 20 referred to be the Examiner) extends not only through the inflator bracket 33 of the air bag inflator 31 and the cushion retention tab 26 (shown in Figure 14) but also through the installation portion 12 of the assist grip 11. Perhaps most importantly, the bolt 35 extends through the air bag cover 15. As set forth in Tajima et al.:

The air bag cover 15 is longitudinally disposed in the location of the roof side rail portion RR extending from the front pillar portion PF through the first and second middle portions P1 and P2 to the rear pillar portion RP as shown in Figures 1 through 4. The air bag cover 15 is disposed between the edge side of a roof head lining 5 and the upper edge side of the openings W1, W2 and W3. The air bag cover 15 is made of a synthetic resin and comprises a door portion 21 and a general portion 16. The door portion 21 is disposed on the lower edge side of the cover 15 so that each air bag 23 can press and open the door portion 21 when the air bag 23 is developed and inflated. The general portion 16 is disposed on the upper side of the door portion 21. On the upper edge side of the door portion 21, a thin hinge portion 20 is formed so that the door portion opens smoothly.

(Tajima et al. Column 7, lines 10-25)

Thus, it is clear that in order to install a combination of Tajima et al.'s air bag module (including air bag inflator 31 and air bag 23A) using bolt 35 and a snap-in clip such as clip 10 of Dickinson et al., the assist grip 11, installation portion 17, and the cover 15 including its general portion 16 and door portion 21 would also have to be preassembled and installed along

with the inflator 31 and air bag 23A, since the bolt 35 passes through these items as well. Furthermore, the cover 15 would have to be aligned properly with the roof rail 5.

Even if Dickinson et al.'s clip 10 were used in place of Tajima et al.'s spring plate nut 37, selective removal of the fastener 35 to permit removal of the air bag module M3 for servicing would require removal of the hand grip 13 and the cap 12b. After this, the installation portion 17, the roof head lining 5 and the air bag cover 15 would be removed. Inflator bracket 33 and the air bag 23A would then be individually removed. For reinstallation, each of these elements would then need separately aligned and held in position to receive the bolt 35. Thus, both removal of Tajima et al.'s bolt 35 and the reattachment thereof are cumbersome processes. The overall complexity and number of components attached to the roof rail inner panel 2 by Tajima et al.'s bolt 35 would not motivate one of ordinary skill to utilize Dickinson et al.'s snap-in clip in place of the spring plate nut 37. In contrast, referring to Figure 3, Applicant's removal process requires only loosening of the serviceability attachment feature 28 and removal of the washer 29 and cushion retention tab 24. Only these two components need be aligned before the serviceability attachment feature 28 is reattached.

Any inference of the teaching of a suggestion or motivation to combine the teachings of Dickinson et al. and Tajima et al. is hindsight reasoning based upon the teachings of the present application. The Federal Circuit makes clear that the best defense against the subtle but powerful attraction of impermissible "hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczaik*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999).

The showing of a suggestion or motivation must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

Accordingly, for at least this reason as well, the rejection under Section 103(a) of independent claims 1, 7 and 10 is improper. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). Thus, the rejection of claims 2-5, 8-9 and 11, which respectively depend therefrom, is improper as well.

Conclusion

This Amendment is believed to be fully responsive to the Office Action mailed June 23, 2004. The remarks in support of the rejected claims are believed to place remaining independent claims 1, 7 and 10, as well as claims 2-5, 8-9 and 11, which respectively depend therefrom, in condition for allowance, which action is requested.

No additional fee is believed to be due. However, please charge any fees that may be associated with this paper to deposit account 07-0960.

Respectfully submitted

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